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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/527,019	03/16/2000	Frampton E. Ellis III	54869.0000095	1601

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EXAMINER	
STASHICK, ANTHONY D	
ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/527,019	ELLIS, FRAMPTON E.	
	Examiner	Art Unit	
	Anthony D Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☒ The proposed drawing correction filed on *05 October 2001* is: a)☐ approved b)☒ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *18* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. In view of the Appeal Brief filed on July 8, 2002, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the mechanical fasteners, a snap fit and "combinations thereof", as stated in claim 24 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. The drawings submitted on October 5, 2001 have been received. The changes to the existing drawing have been approved but the addition of drawing 11Q, being a schematic drawing of the claimed subject matter does not clearly show what applicant is claiming, especially the "combinations thereof". Therefore, this drawing will not be entered.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of

which applicant may become aware in the specification. Furthermore, some or much of the subject matter disclosed appears to be entirely outside the bounds of the claims and is therefore unnecessary to support the instant invention. Under provisions of MPEP 1302.01, the applicant is requested to modify the application to restrict the descriptive matter and Figures so as to be in harmony with the claims. Currently, it appears that only Figures 11A-11R support the instant invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11, 14-20, 22 and 25-31 are rejected under 35 U.S.C. 102(b) as being anticipated by the WO reference to Adidas AG WO 97/46127 (WO '127). WO '127 discloses all the limitations of the claims including the following: a removable midsole orthotic 10 sized to fit inside and form part of the sole of a shoe; a secondary outer sole 14 on at least a portion of the outer surface of the removable midsole orthotic to provide traction or wear resistance when the orthotic inner shoe is worn without the shoe (an overshoe) designed to receive and retain the insertable midsole orthotic; a device (integral upper 16) associated with the removable midsole orthotic for retaining the orthotic shoe on the user's foot when not placed within the shoe (overshoe) designed to receive and retain the midsole orthotic; the orthotic shoe is insertable from the shoe (overshoe) in order to wear the orthotic inner shoe independently of the shoe; upper surface of removable midsole orthotic provides the orthotic effect (i.e. supports or supplements weakened or abnormal joints by providing cushioning for those joints) and provides less than half the thickness of the sole of the removable midsole orthotic; a removable midsole orthotic 10 sized to fit inside a shoe (fits into an overshoe that has a sole and an upper that fits around

the upper of the orthotic shoe); the orthotic including an inner surface (that area where one places one's foot upon); an outer surface (that which is the outsole 14); the midsole having a medial and a lateral side (see Figure 22); a plurality of protrusions (62, 64, 66) on at least one side of the midsole that interacts with the shoe to retain the midsole within the shoe (these portion will be tightly fitted into the overshoe with the elasticity of the overshoe applied to these portions and holding the overshoe on the shoe); at least one portion of the outer surface of each protrusion is concavely rounded (see Figure 22) relative to an inner section of the removable midsole directly adjacent to the concavely rounded portion (protrusions are rounded inwardly); at least one portion of an inner surface of a side of the removable midsole orthotic is convexly rounded relative to a section of the removable midsole orthotic directly adjacent to the convexly rounded inner surface portion (see Figure 22, the protrusion has an outwardly rounded protrusion that has an inner surface that is convex and the outer surface that is concave); the midsole is insertable from the shoe (all shoes are removable from overshoes, thereby the definition of an overshoe); protrusions are located on either side of the midsole (see Figure 19); the protrusions are located in an area near the longitudinal arch (see Figure 22); the midsole tapers on both sides of the protrusion (see Figure 22, tapering occurs between each protrusion); tapered portion can be considered an indentation as 62, 64 and 66 are considered protrusions, depending on one's perspective or reference point); concavely rounded portions of midsole form protrusions (see Figure 22); the outer surface of the protrusions on the outer sole (62, 64 and 66) is concavely rounded to an inner section of the bottom sole adjacent to the concavely rounded section of the bottom sole; inner surface of the protrusions of the bottom sole also similar to the inner surface of the protrusions of the midsole described above; protrusions of bottom sole located on either side of shoe (to fit protrusions of midsole shown in Figure 19); thickness of protrusions of bottom sole taper in similar fashion to that of protrusions of midsole (see Figure 20).

6. Claims 39-44 are rejected under 35 U.S.C. 102(b) as being anticipated by the WO reference to Adidas AG (WO '127). WO '127 discloses all the limitations of the claims including the following; a shoe upper 16, a shoe sole 14 including at least a bottom sole (bottom sole include 14 and the lower sections of 16); at least a portion of the side of the shoe upper being directly attached to the bottom sole so the upper abuts a portion of the outer surface of the removable midsole orthotic (see Figure 22); the removable midsole orthotic is insertable from the shoe and insertable into the shoe from an opening in the upper (see Figure 22); at least two recess in the bottom sole (those formed by the inside of 62, 64 and 66) to thereby releasably retain the removable midsole orthotic; the outer surface of the bottom sole has a plurality of protrusions (62, 64, 66); at least one portion of the outer surface of each protrusion on the bottom sole is concavely rounded relative to an inner section of the bottom sole directly adjacent the concavely rounded outer surface portion (see inside medial arch area of bottom sole); at least one portion of an inner surface of a side of ach said protrusion of the bottom sole is convexly rounded relative to a section of the bottom sole directly adjacent the convexly rounded inner surface portion; one protrusion is located on the lateral side of the bottom sole and another on the medial side (see figure 20); each protrusion is located at a location on the bottom sole which corresponds to at least one of the base of a calcaneus, a lateral tuberosity of the calcaneus, a head of a first distal phalange, a longitudinal arch, a head of a first metatarsal, a head of a fifth metatarsal, and a base of the fifth metatarsal; the bottom sole tapers from a greater thickness to a lesser thickness from the protrusion to a location on one side of the protrusion (see Figure 20, goes from thicker area at protrusion to a thinned area between protrusions on both side of the protrusion).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '127 as applied to claim 25 above in view of Hoyt 5,425,186. WO '127 discloses all the limitations of the claims except the outer shoe upper and sole. Hoyt '186 teaches that a shoe can be covered by an overshoe which consists of a shoe upper 32 and sole 12, 14. This overshoe can be placed over a shoe to protect it from wear and tear as well as inclement weather. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place the shoe of WO '127 in the overshoe of Hoyt '186 to protect the shoe from excessive wear and tear as well as inclement weather. With respect to claim 33, Hoyt '186 clearly shows a portion of side of shoe upper 32 attached directly to the bottom sole 12, 14. With respect to claims 33, the shoe upper 32 would abut at least a portion of the outer surface of the midsole (after midsole is placed within the overshoe).

9. Claims 12 and 13 are is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '127 as applied to claim 11 above in view of Demon 5,813,142. WO '127 discloses all the limitations of the claim except for the compartment containing a fluid, a flow regulator a duct, a control system that automatically adjusts the pressure in the compartment, and a microcomputer. Demon '142 teaches that a shoe sole can be modified to contain a compartment containing a fluid, a flow regulator, a duct, a control system automatically adjusting the pressure in the compartment, and a microcomputer, substantially as claimed. The computer control can be located in an upper portion (as taught by Demon '142) of the removable midsole. Therefore, it would have been obvious to provide the shoe midsole of WO '127 with the system of Demon 142, located in the upper portion of the midsole of WO '127, to reduce the impact of the user's foot on the traveling surface during use.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '127 as applied to claim 11 above in view of Vizy et al. 6,023,857. WO '127 discloses all the limitations as claimed except for an insole located within the midsole orthotic shoe. Vizy et al. '857 teaches in column 1, lines 6-28 that is typical in a shoe to include an insole to aid in comforting the user's foot. Therefore, it would have been obvious, in view of Vizy et al. '857, to place an insole on top of the midsole of the WO '127 reference to aid in giving comfort to the user's foot during wear.

11. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '127 as applied to claim 11 above in view of Hoyt 5,425,186. The WO '127 reference as applied to claim 11 above discloses all the limitations of the claims except for the shoe upper and shoe sole. Hoyt '186 teaches that a shoe can be covered by an overshoe which consists of a shoe upper 32 and sole 12, 14. This overshoe can be placed over a shoe to protect it from wear and tear as well as inclement weather. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place the shoe of WO '127 in the overshoe of Hoyt '186 to protect the shoe from excessive wear and tear as well as inclement weather.

Double Patenting

12. Claims 11-44 of this application conflict with claims 11-45 of Application No. 09/558,629. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

13. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this

context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

14. Claims 11-44 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11-45 of copending Application No. 09/558,629. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented and since it has been determined that there appears to be no difference between the terms "removable" and "insertable" as they are determined to be interchangeable.

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 11-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-45 of copending Application No. 09/558,629. Although the conflicting claims are not identical, they are not patentably distinct from each other because the terms "insertable" and "removable" are interchangeable. Since something that can be inserted can be removed and alternatively something that has been removed can ceratinly be replaced where it has been removed from, i.e. inserted, there appears to be no difference in the claimed subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this

application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http:www.uspto.gov/

Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS
September 22, 2002